

### **REMARKS**

In the Office Action, claims 1-32 were rejected. Claims 1-32 remain pending. In view of the following remarks, Applicant respectfully requests reconsideration and allowance of all pending claims.

#### **Rejections Under 35 U.S.C. § 102**

In the Office Action, the Examiner rejected claims 1-4, 7-11, 13-22, 29, and 30 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Pub. 2002/0082963 (hereinafter "Corvin"). Applicant respectfully traverses this rejection.

#### ***Legal Precedent***

Anticipation under 35 U.S.C. § 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). Every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). The prior art reference must show the *identical* invention "*in as complete detail as contained in the ... claim*" to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Further, during patent examination, the pending claims must be given an interpretation that is reasonable and consistent with the specification. See *In re Prater*, 415 F.2d 1393, 1404-05, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969); see also M.P.E.P. §§ 608.01(o) and 2111. Indeed, the specification is "the primary basis for construing the claims." See *Phillips v. AWH Corp.*, No. 03-1269, -1286, at 13-16 (Fed. Cir. July 12, 2005) (citations omitted). Interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. See *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); M.P.E.P. § 2111. "The inquiry into how a person of ordinary skill in the art understands a claim term provides an

objective baseline from which to begin claim interpretation.” See *Collegenet, Inc. v. ApplyYourself, Inc.*, No. 04-1202, -1222, 1251, at 8-9 (Fed. Cir. August 2, 2005) (quoting *Phillips*).

***Independent Claims 1, 13, 20***

Independent claims 1, 13, and 20 generally provide for an electronic query page that elicits information from a customer about the customer’s radiological imaging system usage. The claims generally further provide for an application or computer program to establish an expected cost reduction (or expected economic benefit) for the customer of using a supplier’s radiological image archiving system (based on the imaging system usage information provided by the customer via the query form).

In particular, claim 1 recites, *inter alia*, “an application stored in the electronic information system, wherein the application establishes an expected cost reduction resulting from using a supplier’s radiological image archiving system based on the customer’s *radiological imaging system usage*.” Independent claim 13 recites, *inter alia*, “wherein the computer program is adapted to enable an electronic information system to establish a customer’s expected cost reductions over a period of time resulting from usage of a supplier’s radiological image archiving system.” Claim 20 recites, *inter alia*, “storing a computer program operable to establish an economic benefit of purchasing a supplier’s radiological image system based on the radiological imaging system information received from a customer on the electronic information system.”

In contrast, the Corvin reference is directed to the feasibility analysis of capital investments in medical resources in general. The focus in Corvin is on investments in medical diagnostic and imaging systems, and the associated impact on healthcare procedures. See, e.g., Corvin, Abstract; ¶¶ 1, 4, and 17; Fig. 3. Corvin never specifically addresses the evaluation of a supplier’s imaging archiving system in relation to the imaging systems that generate the images. Clearly, the Corvin analysis and reporting has nothing

to do with establishing an economic benefit of a picture or image archiving system as a function of the upstream imaging systems usage. *See, e.g.*, Corvin, ¶ 47. Therefore, the Corvin reference can not anticipate claims 1, 13, and 20, or their dependent claims.

It should be emphasized, as appreciated by those skilled in the art, an image archiving system (e.g., picture archive and communication system or PACS), such as those typically found in medical facilities (e.g., hospital), are distinct from the imaging modalities that generate the images. *See, e.g.*, Application, page 3, lines 39 – page 5, lines 35; Fig. 1; *see also Phillips*, at 16 (explaining that one should rely heavily on the written description for guidance as to the meaning of the claims). Therefore, any attempt by the Examiner to characterize the recited imaging archiving system as an upstream imaging modality (disclosed in Corvin) is misplaced.

#### ***Claim 29***

Independent claim 29 recites, *inter alia*, “the query page comprises at least one question designed, when completed by the customer, to enable the information system to *establish an amount of storage capacity in a digital radiological image archiving system* corresponding to an amount of radiological images produced by a customer over a specified time period.” While Corvin discloses query forms, the Corvin forms never speak specifically to a digital radiological image archiving system, much less to enabling the correlation of archiving storage capacity to the amount of images produced by the customer, as required by claim 29. *See, e.g.*, Corvin, Figs. 4-5. Accordingly, the Corvin reference cannot anticipate claim 29 or its dependent claims.

#### ***Request Withdrawal of Rejection***

In view of the foregoing, the Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 102, and allowance of the claims.

***Dependent Claims***

While the dependent claims rejected under 35 U.S.C. § 102 are believed to be patentable because of their dependency on an allowable base claim, the dependent claims are also believed to be patentable by virtue of the subject matter they separately recite. For example, dependent claim 3 recites “wherein the application establishes a suggested radiological image archiving system based on the customer’s radiological imaging system usage.” Conversely, Corvin is absolutely devoid of such an application.

In another example, dependent claim 12 recites “wherein the expected cost reduction comprises a reduction in optical discs used in a customer’s existing radiological image archiving system.” Similarly, dependent claim 32 recites “wherein the application establishes an expected cost savings based on a decrease in optical disc consumption for archiving of radiological images.” Corvin never even mentions optical discs, much less a reduction of such discs.

For the addition reason that the dependent claims separately recite subject not found in Corvin, Applicant respectfully request that the Examiner withdraw the rejection of the dependent claims.

**Rejections Under 35 U.S.C. § 103**

The Examiner rejected claims 5, 23-28, and 31 under 35 U.S.C. § 103(a) as being unpatentable over Corvin in view of U.S. Patent No. 6,574,742. The Examiner rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Corvin in view of U.S. Patent No. 6,260,021. The Examiner rejected claims 12 and 32 under 35 U.S.C. § 103(a) as being unpatentable over Corvin in view of U.S. Patent No. 6,820,100. Applicant respectfully traverses these rejections. Applicant respectfully requests withdrawal of the rejections under 35 U.S.C. § 103 and allowance of the claims.

***Request Removal of Commonly Assigned Reference under 103(c)/102(e)***

Regarding the Corvin reference, Applicant respectfully points out that Corvin should be removed from consideration in accordance with 35 U.S.C. § 103(c) and M.P.E.P. § 706.02(I), because the present application and Corvin were, at the time the invention was made, owned by, or subject to an obligation of assignment to, General Electric Company or one of its commonly used or controlled subsidiaries. Accordingly, Applicant respectfully requests the Examiner remove Corvin from consideration. After Corvin is removed according to 35 U.S.C. § 103(c), the Examiner's § 103 rejections, all of which are based on Corvin, are moot. Accordingly, independent claim 23 and its dependent claims, as well as dependent claims 5, 6, 12, 31, and 32 are believed to be allowable.

**Conclusion**

In view of the remarks and amendments set forth above, Applicant respectfully requests allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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